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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,970	04/02/2004	Elliott D. Light	2735-001CIP	1682
22208	7590	09/23/2004	EXAMINER	
ROBERTS ABOKHAIR & MARDULA SUITE 1000 11800 SUNRISE VALLEY DRIVE RESTON, VA 20191			YAM, STEPHEN K	
			ART UNIT	PAPER NUMBER
			2878	

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/816,970

Applicant(s)

LIGHT ET AL.

Examiner

Stephen Yam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 10/294,273. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both contain the same subject matter and similar claim language except for the claimed system comprising a *plurality* of sensors in the co-pending Application and *a* sensor in the current Application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### *Claim Objections*

3. Claims 1, 5, 7-9, and 11-19 are objected to because of the following informalities:

In Claims 1 and 7, line 2, "the area" lacks proper antecedent basis.

In Claims 5 and 8, line 2, "an imaging system" lacks proper antecedent basis.

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In Claim 7, line 6, "auto focus emissions" lacks proper antecedent basis.

In Claim 9, line 2, "auto focus emissions" lacks proper antecedent basis.

In Claims 11-19, "wherein emitting a thwarting signal" lacks proper antecedent basis, as the limitation is already defined in parent Claim 10.

In Claims 11, 12, and 16-19, "a thwarting signal" lacks proper antecedent basis, as the limitation is already defined in parent Claim 10.

In Claims 13-15, "a thwarting signal generator" lacks proper antecedent basis, as the limitation is already defined in parent Claim 10.

In Claim 14, "*the* periphery of a stage" lacks proper antecedent basis.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 10, 11, and 13-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Kimura et al. US Patent No. 6,742,901.

Regarding Claim 10, Kimura et al. teach (see Fig. 1) a method of thwarting the pirating of a theatrical experience (emitted from (1)) wherein a plurality of thwarting signal generators

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(3) are located proximate to the area (area of (2), (4)) in which the theatrical experience is taking place, the method comprising emitting a thwarting signal (from (3)) that is visible to an imaging system but that is not visible to the human eye (see Col. 19, lines 58-63).

Regarding Claim 11, Kimura et al. teach said emitting a thwarting signal that is visible to an imaging system but that is not visible to the human eye comprising emitting a thwarting signal that is in the infrared region of the spectrum (see Col. 19, lines 58-67).

Regarding Claim 13, Kimura et al. teach (see Fig. 5 and 6) said emitting a thwarting signal comprising emitting the thwarting signal from a thwarting signal generator of the plurality of thwarting signal generators which is attached to on-stage equipment (2).

Regarding Claim 14, Kimura et al. teach (see Fig. 7) said emitting a thwarting signal comprising emitting the thwarting signal from a thwarting signal generator of the plurality of thwarting signal generators which is attached to a periphery of a stage (area of (2) and (4)) (see Fig. 7 and Col. 27, line 66 to Col. 28, line 6 and Col. 30, lines 52-63).

Regarding Claim 15, Kimura et al. teach (see Fig. 1) said emitting a thwarting signal comprising emitting the thwarting signal from a thwarting signal generator of the plurality of thwarting signal generators which is positioned behind a screen (2).

Regarding Claim 16, Kimura et al. teach said emitting a thwarting signal that is visible to an imaging system comprising emitting the thwarting signal to a still photo camera (see Col. 2, lines 4-8).

Regarding Claim 17, Kimura et al. teach said emitting a thwarting signal that is visible to an imaging system comprising emitting the thwarting signal to a moving picture camera (see Col. 2, lines 4-8).

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Regarding Claim 18, Kimura et al. teach said emitting a thwarting signal that is visible to an imaging system comprising emitting the thwarting signal to a CCD array camera (see Col. 2, lines 4-8 and Col. 19, lines 60-63).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimura et al.

Regarding Claim 19, Kimura et al. teach the method in Claim 10, according to the appropriate paragraph above. Kimura et al. also teach the thwarting signal used for any device or system having an image sensor capable of obtaining image data (see Col. 2, lines 4-8). Kimura et al. do not teach emitting the thwarting signal to an imaging cellular telephone. It is well known in the art that some cellular telephones ("picture phones") provide camera functionality using a CCD array to capture an image stored on the telephone. It would have been obvious to one of ordinary skill in the art at the time the invention was made to emit a thwarting signal to an imaging cellular telephone in the method of Kimura et al., to provide piracy thwarting system that encompasses all embodiments of portable image-capture devices, as taught by Kimura et al. (see Col. 2, lines 4-8).

Regarding Claim 19, Kimura et al. teach the method in Claim 10, according to the appropriate paragraph above. Kimura et al. also teach the thwarting signal as an infrared signal (see Col. 19, lines 58-67). Kimura et al. do not teach the thwarting system that is detectable by an auto focus system of an imaging system. It is well known in the art to provide an auto-focus system using an infrared emitter and detector to provide range/distance information for optimal focusing, and that the infrared detector is responsive to infrared radiation, and hence, the thwarting signal which affects the image sensor in a digital camera/camcorder also affects the auto-focus infrared detector. It would have been obvious to one of ordinary skill in the art at the time the invention was made to emit a thwarting signal that is detectable by an auto focus system in the method of Kimura et al., to utilize the thwarting signal of Kimura for multiple forms of adverse reactions towards a digital video recording device for further piracy protection.

8. Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohnishi et al. US Patent No. 6,674,561 in view of Kimura et al.

Regarding Claim 10, Ohnishi et al. teach (see Fig. 7) a method of thwarting the pirating of a theatrical experience (emitted from (2)) wherein a thwarting signal generator (3) is located proximate to the area (in front of (1)) in which the theatrical experience is taking place, the method comprising emitting a thwarting signal (emitted from (3)) that is visible to an imaging system but that is not visible to the human eye (see Col. 12, lines 24-27 and Col. 13, lines 19-34). Regarding Claim 12, Ohnishi et al. teach said thwarting signal as a short duration (modulated) visible light signal not visible to the human eye (see Col. 12, lines 36-47 and Col. 13, lines 19-34). Ohnishi et al. do not teach a *plurality* of thwarting signal generators. Kimura et al. teach

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(see Fig. 1) a similar method, using a plurality of thwarting signal generators (3) for thwarting the pirating of a theatrical experience. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a plurality of thwarting signal generators instead of a single thwarting signal generator, as taught by Kimura et al., in the method of Ohnishi et al., to provide increased thwarting signal coverage and thwarting signal intensity.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wroblewski et al., US Patent No. 6,018,374, teach a system with an infrared source emitting signals to prevent pirating of a movie within a theater.

Sitrick et al. US Patent No. 6,771,349, teach a system with an infrared source emitting signals to prevent pirating of a movie within a theater, with infrared energy sensors to determine the status of the infrared source.

Barkans US Pre-grant Publication No. 2004/0091110, teaches a system which emits optical energy outside the range of human perception to thwart the recording of a movie within a theater.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Yam whose telephone number is (571)272-2449. The examiner can normally be reached on Monday-Friday 8:30am-5pm.



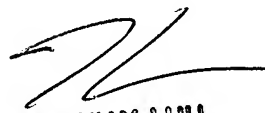
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Porta can be reached on (571)272-2444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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THANH X. LUU  
PATENT EXAMINER